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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,641	07/28/2003	Takashi Sumikawa	60188-591	3603

7590 08/30/2005

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EXAMINER

DO, THUAN V

ART UNIT	PAPER NUMBER
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2825

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/627,641	SUMIKAWA, TAKASHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thuan Do	2825	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/28/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is responsive to response entered on 07/27/2005. Claims 1-7 are pending in this office action since the restriction was elected on 07/27/2005. Claims 8-12 are requested to cancel in the next response.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention in the following areas:

The terms:

“respective performances”. What is the definition of respective regarding to performance?

“types”. What is the definition?

“a third step of predicting, using a predicted value or a target value for performance of a third circuit of the same type as that of the first circuit and in accordance with a next generation process and the performance correlation coefficient obtained in the second step, performance of a fourth circuit of the same type as that of the second circuit in accordance with the next generation process”.

Examiner does not understand how and including the output of a third step of predicting that can be performed in term of each members such as “ using... of the same type as that of the first circuit”, “in accordance with a next generation process” or “the performance correlation coefficient... in accordance with the next generation process”.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in-  
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-3,5-7 are rejected under 35 U.S.C. 102(e) as being unpatentable over Voorakaranam et al. Pub. No. 20020133772.

**Regarding claim 1:** Voorakaranam teaches a method comprising:

a first step of obtaining respective performances of different types of first and second circuits in accordance with an existing generation process (paragraph [0004] using test time performances);

a second step of obtaining a performance correlation coefficient between the first and second circuits (paragraph [0032] ); and

a third step of predicting, using a predicted value or a target value for performance of a third circuit of the same type as that of the first circuit and in accordance with a next generation process and the performance correlation coefficient obtained in the second step, performance of a fourth circuit of the same type as that of the second circuit in accordance with the next generation process (paragraphs [0010] and [0031]).

**Regarding claims 2,3:** Voorakaranam teaches a method with fourth and fifth steps (paragraphs [0010] and [0037]).

**Regarding claim 7:** Voorakaranam teaches a method with library (paragraphs [0040] and [0041]).

The remaining claims of 102(e) section contain features similar to the rejection of claims 1-3 and/or 7 and rejected in the rationale.

***Allowable Subject Matter***


Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reason for allowance is that the prior art of record does not teach the dependent claims with all other features of the independent claim.

**CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan Do whose telephone number is 571-272-1891. The examiner can normally be reached on Monday-Friday 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on 571-272-1907. The fax phone numbers for proceeding this application is 571 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0596.



Thuan Do  
Primary examiner  
08/26/2005